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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,797	09/26/2003	Graham P. Allaway	1900.0400001/JMC/SMW	7896
26111	7590	12/14/2004	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			REYES, HECTOR M	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/670,797

**Applicant(s)**

ALLAWAY ET AL.

**Examiner**

Hector M Reyes

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## ELECTION RESTRICTION REQUEST

### Status of The Claims

Currently, claims 1-29 are active in the instant claims and are hereby subjected to restriction as follows.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims **1-13** drawn to a series of derivatives as described in the said claims or salts thereof and simple compositions comprising the same classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. *A single disclosed species is hereby requested for search purpose.***
- II. Claims **14-19** drawn multiple complex pharmaceutical compositions as described in the said claims, classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. *A single disclosed species is hereby requested for search purpose.***
- III. Claims **20-25** drawn a method for **inhibiting** any retroviral infection including **HIV** infection, as described in the said claims classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. *A single disclosed species is hereby requested for search purpose.***

- IV. Claims **26-27** drawn a method for **treating** a patient suffering from any retroviral-related pathology any retroviral infection as described in the said claims classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- VII. Claims **28** drawn a method for **preventing** transmission of **HIV infection** from an infected pregnant woman to a fetus as described in the said claim classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**
- VIII. Claims **29** drawn a method for **preventing transmission of HIV infection** during sexual intercourse as described in the said claim classified in multiple classes and multiple subclasses. **This group may be subjected to further restriction. A single disclosed species is hereby requested for search purpose.**

The inventions are distinct, each from the other because of the following reasons:

Each Invention have its own particular set of limitations and patentability requirements that a reference anticipating or suggesting any of the above Inventions does not

necessarily disclose or suggest any of the other Inventions under the meaning of 35 USC 102 and 103, representing thus a serious burden to the Examiner's search.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for a given Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In the event that Applicant's election is directed to an Invention drawn to compounds, the Examiner will be willing to rejoin claims directed to a method of using the said compounds and simple pharmaceutical compositions comprising the same, with the proviso that the said claims are free from any 112 issues.

### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (571) 272-0691. The examiner can normally be reached on M-F (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rita Desai can be reached on (571) 272-0684. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hector M. Reyes PhD JD  
Reg. # P-54, 846  
Au 1625  
December 10, 2004

Ms. Rita Desai  
Primary Examiner

*R. Desai*  
\_\_\_\_\_  
12/10/04.